



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,842	07/22/2003	Robert Lance Cook	25791.151	7856

27683 7590 01/10/2006

HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

EXAMINER

BOMAR, THOMAS S

ART UNIT	PAPER NUMBER
----------	--------------

3672

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/624,842

Applicant(s)

COOK ET AL.

Examiner

Shane Bomar

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39, 42-55 and 60-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2, 10-39, 42-49 and 65 is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 50-55, 60-64 and 66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/12/05, 8/19/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 8, 9, 54, 55, 64, and 66 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US patent 4,836,579 to Wester et al.

Regarding claims 1, 3, 64, and 66, Wester et al disclose a wellhead, or an apparatus, comprising an outer casing 18 at least partially positioned within a wellbore, and a plurality of inner casings 14 and 16 indirectly coupled to the interior surface of the outer casing 18 by hanger assemblies 10 and 12, wherein adjacent inner casings define an annulus therebetween (see Fig.

1). It is noted that the instant claims involve a product (a plurality of inner casings coupled to the interior surface of an outer casing) by process (expanding each of the inner casings into contact with a portion of the interior surface of the casing). In such cases, it is the stance of the Office that the product itself does not depend on the process of making it and the process is given little patentable weight. The claimed wellhead, or apparatus, appears to be essentially the same as the

Art Unit: 3672

prior reference material, since both have a plurality of inner casings coupled to the interior surface of an outer casing. Regardless of whether the inner casings are expanded into contact with the outer casing, as in the claim, or placed into contact with the outer casing via casing hangers, as in the prior art reference, the product itself appears to be the same.

Regarding claims 8 and 54, one or more seals 24 and 26 are positioned in the interface between the inner casings and the outer casing (see Fig. 1 and col. 2, lines 48-52).

Regarding claims 9 and 55, the inner casings are supported by their contact with the outer casing (see Fig. 1).

4. Claims 1, 3, 8, 9, 54, 55, 60-64, and 66 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US patent 4,595,063 to Jennings et al.

Regarding claims 1, 3, 64, and 66, Jennings et al disclose a wellhead, or an apparatus, comprising an outer casing 38 at least partially positioned within a wellbore, and a plurality of inner casings 26 and 28 indirectly coupled to the interior surface of the outer casing 38 by hanger assemblies 20 and 22, wherein adjacent inner casings define an annulus therebetween (see Fig. 1). It is noted that the instant claims involve a product (a plurality of inner casings coupled to the interior surface of an outer casing) by process (expanding each of the inner casings into contact with a portion of the interior surface of the casing). In such cases, it is the stance of the Office that the product itself does not depend on the process of making it and the process is given little patentable weight. The claimed wellhead, or apparatus, appears to be essentially the same as the prior reference material, since both have a plurality of inner casings coupled to the interior surface of an outer casing. Regardless of whether the inner casings are expanded into contact

Art Unit: 3672

with the outer casing, as in the claim, or placed into contact with the outer casing via casing hangers, as in the prior art reference, the product itself appears to be the same.

Regarding claims 8 and 54, one or more seals 70 are positioned in the interface between the inner casings and the outer casing (see Fig. 1 and col. 3, lines 7-9).

Regarding claims 9 and 55, the inner casings are supported by their contact with the outer casing (see Fig. 1).

Regarding claim 60, Jennings et al disclose a wellhead comprising an outer casing 38 at least partially positioned within a wellbore, and a plurality of inner casings 26 and 28 indirectly coupled to the interior surface of the outer casing 38 by hanger assemblies 20 and 22, wherein adjacent inner casings define an annulus therebetween, and wherein each inner casing comprises: a first tubular portion 20 or 22 supported by indirect contact pressure between an outer surface of the first tubular portion and the inner surface of the outer casing (see Figs. 1 and 2), and a second tubular portion 26 or 28 extending from and coupled to the first portion that is spaced apart from the outer casing in a radial direction (see Fig. 1). Again, as noted above with respect to claims 1, 3, 64, and 66, this is a product by process claim and the product itself does not depend on the process of making it and the process is given little patentable weight.

Regarding claims 61-63, the first tubular portions are spaced apart in a longitudinal direction and/or the second tubular portions are spaced apart in a radial direction (see Fig. 1).

5. Claims 1, 3, 8, 9, 54, 55, 60-64, and 66 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US patent 4,550,782 to Lawson.

Regarding claims 1, 3, 64, and 66, Lawson discloses a wellhead, or an apparatus, comprising an outer casing 16/14 at least partially positioned within a wellbore, and a plurality of

Art Unit: 3672

inner casings 32, 34, and 36 indirectly coupled to the interior surface of the outer casing 16/14 by hanger assemblies 18, 20, and 22, wherein adjacent inner casings define an annulus therebetween (see Fig. 1). It is noted that the instant claims involve a product (a plurality of inner casings coupled to the interior surface of an outer casing) by process (expanding each of the inner casings into contact with a portion of the interior surface of the casing). In such cases, it is the stance of the Office that the product itself does not depend on the process of making it and the process is given little patentable weight. The claimed wellhead, or apparatus, appears to be essentially the same as the prior reference material, since both have a plurality of inner casings coupled to the interior surface of an outer casing. Regardless of whether the inner casings are expanded into contact with the outer casing, as in the claim, or placed into contact with the outer casing via casing hangers, as in the prior art reference, the product itself appears to be the same.

Regarding claims 8 and 54, one or more seals 244 are positioned in the interface between the inner casings and the outer casing (see Fig. 1 and col. 7, lines 34-35).

Regarding claims 9 and 55, the inner casings are supported by their contact with the outer casing (see Fig. 1).

Regarding claim 60, Jennings et al disclose a wellhead comprising an outer casing 16/14 at least partially positioned within a wellbore, and a plurality of inner casings 32, 34, and 36 indirectly coupled to the interior surface of the outer casing 16/14 by hanger assemblies 18, 20, and 22, wherein adjacent inner casings define an annulus therebetween, and wherein each inner casing comprises: a first tubular portion 18, 20, or 22 supported by contact pressure between an outer surface of the first tubular portion and the inner surface of the outer casing (see Figs. 1 and 7), and a second tubular portion 32, 34, or 36 extending from and coupled to the first portion that

Art Unit: 3672

is spaced apart from the outer casing in a radial direction (see Fig. 1). Again, as noted above with respect to claims 1, 3, 64, and 66, this is a product by process claim and the product itself does not depend on the process of making it and the process is given little patentable weight.

Regarding claims 61-63, the first tubular portions are spaced apart in a longitudinal direction and/or the second tubular portions are spaced apart in a radial direction (see Fig. 1).

Claim Rejections - 35 USC § 103

6. Claims 4-7 and 50-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wester et al, Jennings et al, or Lawson as applied to claims 1 and 3 above in view of US patent 6,354,373 to Vercaemer et al.

Regarding claims 4 and 50, Wester et al, Jennings et al, or Lawson teach the wellhead or apparatus of claims 1 or 3 that includes inner casings. It is not taught that extruding the inner casings off of a mandrel expands the inner casings.

Vercaemer et al teach an inner casing 29 coupled to an outer casing similar to that of the aforementioned prior art references (see Fig. 5 and col. 5, lines 5-8). It is further taught that the inner casing 29 is extruded off of a mandrel 36 to expand the casing (see Fig. 5). It would have been obvious to one of ordinary skill in the art, having the teachings of the three previous references and Vercaemer et al before him at the time the invention was made, to modify the wellhead or apparatus taught by the three previous references to include the expandable casing and expansion mandrel of Vercaemer et al. One would have been motivated to make such a combination since Vercaemer et al have shown it to be notoriously known in the art to expand casings with a mandrel and because it was also notoriously known in the art, at the time the

Art Unit: 3672

invention was made, that expanding a tubular within a wellbore or casing eliminates the need for conventional slips or other hanging means, thereby simplifying and reducing the costs of the casing operation.

The combination applied to claims 4 and 50 above also applies to claims 5 and 51, wherein the inner casings are only claimed as being expanded. This is because, again, these are product by process claims and the product itself does not depend on the process of making it. Therefore, the combination of one of the three prior references and Vercaemer et al would produce a wellhead or apparatus with inner casings that are expanded. Furthermore, the limitations of claims 6, 7, 52, and 53 are limitations of the process and do not add anything to the product itself, therefore these claims only require what is required of claims 5 and 51.

Allowable Subject Matter

7. Claims 2, 10-39, 42-49, and 65 are allowed.

Response to Arguments

8. Applicant's arguments filed 10/20/2005 have been fully considered but they are not persuasive. The Applicant has added the limitation "by contact pressure between an outer surface of each of the plurality of inner casings (or tubular members) and the interior surface of the outer casing or tubular member)" to claims 1, 3, and 64 in an attempt to traverse the previously presented rejections. However, this limitation is simply a functional limitation that does not add any structure to the claim. In fact, the amendment does not appear to add any

functional limitation to the claim because the contact pressure is a natural result of the expansion process and would be inherent to one of ordinary skill in the art.

As noted in the prior art rejections above, the apparatus claims 1, 3, 60, 64, and 66 contain process of expanding steps in an attempt to modify an apparatus with process limitations, thereby making these claims product-by-process claims. The process by which the resultant apparatus is achieved is given little patentable weight, and the apparatus only need be capable of being formed by the claimed process. All of the aforementioned prior art references are capable of being expanded as is it notoriously known in the art that any tubular object is capable of expansion. Therefore, all of the rejections restated above are still considered to be valid and applicable against the currently presented claims.

Lastly, with specific respect to claim 60, the tubular hangers of the above references are seen as the first tubular portions and are supported by contact pressure with the inner surface of the inner casing. Although it is an indirect contact pressure, it is still a contact pressure and the claim does not specify whether the pressure need be indirect or direct.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

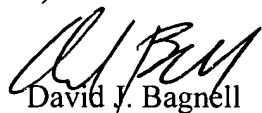
Art Unit: 3672

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 6:30am to 4:00pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Bagnell
Supervisory Patent Examiner
Art Unit 3672



tsb

January 3, 2006